REMARKS

In the Office Action mailed August 30, 2005, the Examiner rejected claims 1 and

9 under 35 U.S.C. § 112, second paragraph, rejected claims 1-4, 7, 9-13, and 15 under

35 U.S.C. § 103(a) as being unpatentable over *Vahalia et al.* (U.S. Patent No.

6,192,408) in view of *Srivastava* (U.S. Patent No. 6,684,331), and rejected claims 5, 6,

13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Vahalia et al.,* in view

of *Srivastava,* in further view of *Bhaskaran et al.* (U.S. Patent No. 6,601,084).

By this amendment, Applicants amend claims 1 and 9. Based on the following

remarks, Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a).

I.   The Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 1-7 and 9-15 under 35 U.S.C. § 112, second

paragraph because the phrase "the same storage location" recited in claims 1 and 9

lacks antecedent basis. Applicants have amended this phrase to recite "a same storage

location." Because amended claims 1 and 9 are definite, Applicants request that the

rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

II.   The Rejections Under 35 U.S.C. § 103(a)

a.   Claims 1-4, 7; 9-13, and 15

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three

basic criteria must be met. First, the prior art reference or references, taken alone or

combined, must teach or suggest each and every element recited in the claims. *See*

M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary

skill in the art, to combine the references in a manner resulting in the claimed invention.

See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. *See*

M.P.E.P. § 2143.02. Moreover, each of these requirements must "be found in the prior

art, and not based on applicant's disclosure." *See* M.P.E.P. § 2143. Applicants

traverse the rejection of claims 1-4, 7, 9-13, and 15 because the Examiner has not

established a *prima facie* case of obviousness.

The Examiner asserts *Vahalia et al.* teaches, among other things, a plurality of

file server devices, each performing only file input-output functions and load balancing

principals. (OA at 4.) The Examiner, however, admits that *Vahalia et al.* does not teach

a load balancer, as recited in claim 1. To compensate for this deficiency, the Examiner

asserts *Srivastava* teaches a virtual address connection and load balancer and

suggests it would have been obvious to combine the cited art to teach the recitations of

claim 1. (OA at 4.) Applicants respectfully disagree for the following reasons.

The Examiner is misplaced in asserting the data movers disclosed by *Vahalia et*

al. are a plurality of file server devices that each perform only file input-output type

functions. Instead, *Vahalia et al.* discloses a network file server system that includes

sets of data movers for servicing requests from clients for read-write access to file

systems. (2:19-22.) The data movers, however, perform more than input-output type

functions. According to *Vahalia et al.*, the first set of data movers are "each configured

for authorizing requests for access to a plurality of read-write file systems in the first set

of file systems." (2:30-33.) Further, *Vahalia et al.* states "[o]ne and only one of the data

mover computers in the first set of data mover computers is assigned to perform lock

management and data access for each of the file systems in the first set of file

systems." (2:33-37.) *Vahalia et al.* also discloses a second set of data movers that are

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each "configured for authorizing requests for access to read-write file systems in the second set of file systems." (2:41-44.) Similar to the first set of data movers, "[o]ne and only one of the data mover computers in the second set of data mover computers is assigned to perform lock management and data access for each of the file systems in the second set of file systems." (2:44-48.) Accordingly, *Vahalia et al.* does not teach a plurality of file server devices, each performing *only* file input-output type functions and capable of performing the file transfer function requested by the client terminal, as recited in claim 1. Instead, the data mover computers disclosed by *Vahalia et al.* perform other functions, such as authorizing requests for access to file systems, which is distinguished from performing only input-output type functions. (*See e.g.,* Applicants' specification, ¶ 23, "server devices 124 may perform only file input-output type functions, and thus may not perform any server based processes, data manipulation, printing functions, or user authorization functions.")

Accordingly, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 1 because the cited art does not teach or suggest at least a plurality of file server devices, as recited in the claim. Therefore, Applicants respectfully request the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Moreover, *prima facie* obviousness has not been established at least because the requisite motivation to combine *Vahalia et al.* and *Srivastava* is lacking. Determinations of obviousness must be supported by evidence in the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). Further, the desire to combine

references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

The M.P.E.P. makes clear that: "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citations omitted). The Examiner has not shown that the cited art "suggests the desirability" of the alleged combination. Indeed, there is no reason why a skilled artisan would look to modify *Vahalia et al.* with the features disclosed by *Srivastava,* as asserted by the Examiner. Therefore the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claim 1, and thus, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn.

Claims 2-4 and 7 depend from claim 1. As explained, the cited art does not support the rejection of claim 1 under 35 U.S.C. § 103(a). Accordingly, the cited art also does not support the rejection of claims 2-4 and 7 for at least the same reasons set forth above in connection with claim 1. Therefore, Applicants request that the rejection of claims 2-4 and 7 be withdrawn, and the claims allowed.

The Examiner rejects claims 9-13 and 15 for the same reasons set forth for claims 1-4 and 7. (OA at 6.) As explained, he cited art does not support the rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a). Accordingly, the cited art also does not

support the rejection of claims 9-13 and 15 for at least the same reasons set forth above in connection with claims 1-4 and 7. Therefore, Applicants request that the rejection of claims 9-13 and 15 be withdrawn, and the claims allowed.

b.   Claims 5, 6, 13, and 14

The Examiner admits that *Vahalia et al.* and *Srivastava* do not teach a load balancer that randomly determines the file server device that will perform the server function and performs load balancing according to a predetermined rotational order. (OA at 6-7.) The Examiner asserts, however, *Bhaskaran et al.* teaches this feature and concludes it would have been obvious to modify the alleged combination of *Vahalia et al.* and *Srivastava* with *Bhaskaran et al.* to suggest the recitations of claims 5, 6, 13, and 14. (OA at 6-7.)

Claims 5 and 6 depend from claim 1 and claims 13 and 14 depend from claim 9. As explained, *Vahalia et al.* and *Srivastava*, alone or in combination, do not support the rejection of claims 1 and 9 under 35 U.S.C. § 103(a). Accordingly, *Vahalia et al.* and *Srivastava* also do not support the rejection of claims 5, 6, 13, and 14 for at least the same reasons set forth above in connection with claims 1 and 9. Further, *Bhaskaran et al.* does not teach or suggest the features missing from *Vahalia et al.* and *Srivastava*. Therefore, Applicants request that the rejection of claims 5, 6, 13, and 14 be withdrawn, and the claims allowed.

III.   Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
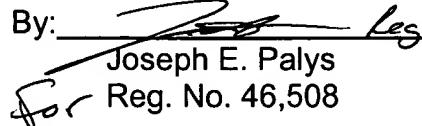
Dated: December 30, 2005   By: _____ Reg. No. 53,056
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